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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/679,438
Filing Date: October 07, 2003
Appellant(s): WYMAN ET AL.

Stephen A. Soffen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/14/2011 appealing from the Office action mailed 7/27/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-5, 11, and 12.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(**5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,074,403	Nord	6-2000
6,071,299	Dingler et al.	6-2000
5,456,684	Schmidt et al.	10-1995
2,518,994	Miller	8-1946

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nord (US 6,074,403) in view of Miller (US 2,518,994) and Schmidt et al. (US 5,456,684; "Schmidt"). Nord discloses an arthroscopic instrument comprising a shaft having a sharp distal tip (4) for capturing and retrieving suture within a patient's body, an articulating mechanism (8) disposed on the shaft and in communication with the sharp tip and a handle extending from the shaft. Nord fails to disclose the claimed single lever handle, the rod, and the spring.

Miller teaches a handle used to manipulate jaws at the end of a medical instrument wherein the handle (figure 1) comprises a single lever (25) disposed pivotably on the handle and manipulable by a user's thumb, while the handle is held across the user's palm and the handle is gripped in the user's hand and the shaft extends distally away from the user's thumb. Miller further teaches that it is well known to use a rod linking an end effector with an actuating lever wherein the lever includes a cam mechanism (surface 27) that engages and cooperates with the rod (17) to move the rod longitudinally within the shaft, thereby actuating the jaws. Miller also teaches a spring (22) that pushes the rod against the cam surface (see column 3, lines 32-46 of Miller). It would have been obvious to one skilled in the art to have modified the device of Nord to include a handle with the lever actuator taught by Miller because such a modification can be considered a simple substitution of one known end effector actuating handle for another known end effector actuating handle with predictable results. It would also have been obvious to include a cam surface, push rod, and spring which cause the articulating mechanism to open and close as taught by Miller since Nord is silent on how movement of the handle is translated to the articulating mechanism and Miller teaches a configuration that is simple in construction, economical to manufacture, and highly efficient in performing its intended function of removing foreign objects from the body (see column 1 lines 7-12 and 42-46 of Miller). The lever taught by Miller toggles between two positions but these two positions are not symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft. However, such a trigger type lever that toggles between two such symmetric positions is known in the art. For example, Schmidt teaches a trigger lever (31) that toggles between two positions that are symmetric as shown in figure 2 (note the recess 35 allows for symmetric toggling) in order to control longitudinal movement of an elongated member. It would have been obvious to modify the lever taught by Miller to shape the lever in a similar manner to that disclosed by Schmidt so that it may toggle between the claimed symmetric positions because such a modification can be considered a simple substitution of one known pivoting trigger-type lever for another with predictable results. Furthermore, no criticality is given in the instant specification for this symmetry and it appears that such a change amounts to a mere change in shape and it has been held that, absent persuasive evidence that a particular shape is significant, the shape can be considered a mere design consideration (*In re Dailey,* 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

Regarding claims 2-5, see figure 1 of Miller. The handle can be considered unitary and extends longitudinally from the shaft (note portion of handle that surrounds rod and shaft). The spring urges the lever into one of the two opposed positions (see column 3, lines 32-46).

Regarding claim 3, the lever can be considered disposed on the top side of the handle since this is dependent on how the instrument is being held. Furthermore, it is noted that a mere rearrangement of parts of an invention involves only routine skill in the art (*In re Japikse,* 86 USPQ 70).

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nord in view of Dingler (US 6,071,299). Nord discloses an arthroscopic instrument comprising a shaft having a sharp distal tip (4), an articulating mechanism (8) disposed on the shaft and in communication with the sharp tip and a handle extending from the shaft. Nord fails to disclose the claimed pliers-like grip.

Dingler teaches that pliers-like grips on instruments with a moving jaw are well known. Dingler further teaches that it is well known to construct such a grip from one curved movable lever (11) and one curved stationary handle (12) wherein the lever and handle have substantially similar but opposite curved shapes and are substantially symmetric relative to a longitudinal axis of the instrument when in the closed position (figure 2) and wherein the handle and lever are asymmetrical with respect to the longitudinal axis when they are in the open position (figure 1). It is noted that the claim includes that the lever and handle are “substantially” symmetric and therefore the handle and lever taught by Dingler meet this limitation, and the open position (figure 1) is considerably asymmetric as compared to the closed position (see figures 2 and 5). The handle taught by Dingler also includes a spring arrangement (14) disposed between the curved stationary handle and the curved movable lever to urge the instrument into a normally open position. It would have been obvious to one skilled in the art to have modified the device of Nord to include a handle with the pliers-like grip taught by Dingler because such a modification can be considered a simple substitution of one known end effector actuating handle for another known end effector actuating handle with predictable results. One skilled in the art has good reason to pursue the known technical options within his or her grasp including various known actuating handles. If this leads to the anticipated success, it is likely the product of ordinary skill and common sense.

(10) Response to Argument

Regarding the combination of Nord in view of Miller and Schmidt, Appellant argues that Nord “specifically teaches against the claimed invention”. This is not found persuasive as Appellant has not provided any specific citations from the Nord reference itself that indicate that Nord teaches away from the claimed invention in a manner that would make modifying Nord in view of Miller and Schmidt non-obvious. The citation that Appellant points out is taken from paragraphs 2 through 4 of the instant application's specification and not from the prior art of Nord. If it is Appellant’s position that, by teaching a certain handle Nord is teaching away from every other handle or any possible handle modifications, this is not found persuasive. Disclosure of a particular embodiment of a device is not necessarily considered a teaching away from any other embodiment or any modification that may be made to that device. Nord does not disclose any disadvantages associated with a handle as taught by Miller and Schmidt and therefore cannot be considered to teach away for such a modification.

Regarding the limitation that the lever is “manipulable by a user’s thumb while the handle is held across the palm of the user's hand and the handle is gripped in the user's hand", it is noted that this is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is possible for the user to pivot the lever (25) taught by Miller with their thumb while the grip portion (11) of the handle taught by Miller is held across the palm of the user and gripped in the user's hand and therefore the device of Nord as modified to include the handle of Miller meets the claim.

Appellant argues that the single lever (25) taught by Miller is not disposed on the handle taught by Miller. This is not found persuasive as the handle (10) of Miller includes a grip portion (11) and bearing portion (12), the bearing portion having a bore (13) and slot (14) (see column 2, lines 17-22). As can be seen in figure 1 of Miller, the lever (25) is disposed on the bearing portion of the handle.

Although Miller does not disclose that the lever toggles between two opposed, symmetrical positions, Schmidt teaches a similar handle having a trigger-type lever (31) that toggles between two positions that are symmetric as shown in figure 2 (note that recess 35 allows for symmetric toggling) in order to control longitudinal movement of an elongated member. It would have been obvious to modify the lever taught by Miller to shape the lever in a similar manner to that disclosed by Schmidt so that it may toggle between the claimed symmetrical positions because such a modification can be considered a simple substitution of one known pivoting trigger-type lever for another with predictable results. Appellant points out that Schmidt discloses several other switches and finger loops on the same handle. However, the examiner has used Schmidt only to show that a modification of the lever to toggle between two opposed symmetrical positions would have been obvious.

Regarding the combination of Nord in view of Dingler, Appellant again argues that Nord teaches against the claimed invention but does not disclose any citations from the Nord reference that include such teachings. The only citations given are from the instant application's specification. Appellant argues that the pliers-type grip taught by Dingler fails to disclose a spring arrangement disposed between a curved stationary handle and a curved movable lever to urge the instrument into a normally open position. This is not found persuasive as Dingler teaches a spring arrangement (14) which is disposed between a curved movable lever (11) and a curved stationary handle (12) and is biased to urge the two handles away from each other (see column 2, lines 9-11 and column 3, lines 12-18). The presence of the ratchet mechanism (15, 16) holds the handles in a certain position against the biasing of the spring but the spring can still be considered to bias the handles away from each other. Dingler discloses that, in order to close the jaws, the movable handle arm (11) is pivoted to its closed position against the effect of the spring (column 3 lines 12-18). Therefore, the spring is biasing the handles into their normally open position. Furthermore, the ratchet mechanism may be released by actuating lever (17), at which time the spring biases the handles away from each other into their open position.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kathleen Sonnett

/Kathleen Sonnett/
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